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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW E. FANO

Appeal 2009-004497
Application 10/064,477
Technology Center 2100

Decided: March 23, 2010

Before JOHN A. JEFFERY, JAMES D. THOMAS, and LEE E. BARRETT,
Administrative Patent Judges.

JEFFERY, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-8, 10-25, 27, 29, and 32. Claims 9, 26, 28, 30, and 31 have been canceled. App. Br. 1. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

STATEMENT OF THE CASE

Appellant invented a system for automatically indexing media files with information related to the subject of the media file. The index is searchable to retrieve relevant media files. *See generally* Spec. ¶¶ 0007-08.

Claim 1 is reproduced below with the key disputed limitations emphasized:

1. A method for media indexing comprising:

capturing a subject in a media file with a media capture device;

automatically receiving, by the media capture device, index information, separate from the media file from an external source, related to the subject and comprising an event indicator that a specific event is occurring; and

associating, by the media capture device, the index information with the media file.

The Examiner relies on the following as evidence of unpatentability:

Cobbley	US 5,818,510	Oct. 6, 1998
Katseff	US 5,822,537	Oct. 13, 1998
Narayanaswami	US 2003/0011684 A1	Jan. 16, 2003 (filed May 18, 1998)

THE REJECTION

The Examiner rejected claims 1-8, 10-20, 23-25, 27, 29, and 32¹ under 35 U.S.C. § 103(a) as unpatentable over Cobbley and Narayanaswami. Ans. 3-12.²

¹ The Examiner's Answer states that claims 1-8 and 10-32 are rejected based on Cobbley and Narayanaswami. We presume this is a typographical error

CLAIM GROUPING

As dependent claims 2, 3, 10-12, 14-18, 20-24, and 32 rely upon the arguments made in connection with independent claims 1, 8, 13, 19, and 27 (*see* App. Br. 22), Appellant groups the following claims together: (1) claims 1-3; (2) claim 4; (3) claim 5; (4) claim 6; (5) claim 7; (6) claims 8 and 10-18; (7) claims 19, 20, 23, and 24; (8) claims 25 and 29; (9) claims 27 and 32; and (10) claims 21 and 22. *See* App. Br. 7-23. Accordingly, we select claims 1, 8, 19, 25, and 27 as representative of groups (1) and (6)-(9). *See* 37 C.F.R. § 41.37(c)(1)(vii).

CONTENTIONS

The Examiner finds that Cobbley discloses all the limitations of representative independent claim 1, except for index information comprising an event indicator that a specific event is occurring. Ans. 3-4. The Examiner relies on Narayanaswami's teaching of an image capturing device that records various information (discussed in ¶¶ 0035 and 0049) to read on an event indicator that a specific even is occurring. Ans. 4. The Examiner additionally provides a motivation for including such information with Cobbley's index information so as to verify the authenticity of and index the captured images. Ans. 4, 14, and 15.

since claims 9, 26, 28, 30, and 31 have been canceled. App. Br. 1. Additionally, claims 21 and 22 were finally rejected based on Cobbley, Narayanaswami, and Katseff. *See* Final Rejection mailed Dec. 12, 2007.

² Throughout this opinion, we refer to (1) the Appeal Brief filed March 31, 2008 and supplemented April 1, 2008; (2) the Examiner's Answer mailed June 11, 2008; and (3) the Reply Brief filed August 11, 2008.

Regarding claim 1, Appellant argues Narayanaswami fails to teach index information because the recorded information is a watermark that is hidden and unsearchable. App. Br. 13-14. Appellant also contends that Narayanaswami's "index information" containing the time, the date, and geographic positions does not include an event indicator that a specific event is occurring as recited in claim 1. App. Br. 14-15. Appellant further argues combining Narayanaswami with Cobbley teaches away from Narayanaswami's purpose of hiding information and renders Narayanaswami unsatisfactory for its intended purpose. App. Br. 15-16.

Regarding claim 4, Appellant refers to previous arguments made with respect to claim 1 and additionally argues that neither Cobbley nor Narayanaswami teaches enabling a commercial system. App. Br. 16-17.

Regarding claim 5, Appellant refers to previous arguments made with respect to claim 1 and additionally contends: (a) Cobbley associates the index information with the media file before transmission from the media indexing beacon since the index information is concurrently sent with the video/audio data; (b) Cobbley does not disclose a media indexing beacon; and (c) Narayanaswami does not cure these deficiencies. App. Br. 17-18.

Regarding claim 6, Appellant refers to previous arguments made with respect to claim 1 and additionally argues that neither reference teaches a media indexing beacon or an index information request to the beacon. App. Br. 18-19.

Regarding claim 7, Appellant refers to previous arguments made with respect to claim 1 and additionally contends that neither Cobbley nor Narayanaswami teaches commercial information and URLs. App. Br. 19.

Regarding independent claim 8, Appellant refers to the arguments made in connection with claim 1. Specifically, Appellant contends neither reference teaches: (1) index information relating to a subject and comprising an event indicator; (2) receiving an index information request that is generated by a media capture device; or (3) transmitting the index information separate from the broadcast information. App. Br. 20-21.

Regarding independent claim 19, Appellant argues that Cobbley does not disclose an index beacon or a separate media capture device that captures the subject and separately receives a beacon signal. App. Br. 21.

Regarding independent claim 25, Appellant refers to all the previous arguments. App. Br. 21.

Regarding independent claim 27, Appellant contends that Cobbley does not disclose a media indexing beacon. App. Br. 21-22.

Regarding claim 21, Appellant argues that the claim limitations of independent claim 19 are not taught by Cobbley or Narayanaswami. Appellant also contends that Katseff does not teach a media indexing beacon or a media capture device separate from the media indexing beacon. App. Br. 22-23.

The issues before us, then, are as follows:

ISSUES

1. Under § 103, has the Examiner erred in rejecting claims 1, 8, and 25 by finding that Cobbley and Narayanaswami collectively would have taught or suggested transmitting index information separate from the media file?

2. Under § 103, has the Examiner erred in rejecting claims 1, 8 and 25 by finding that Cobbley and Narayanaswami collectively would have taught or suggested index information comprising an event indicator that a specific event is occurring?

3. Under § 103, in rejecting claims 1, 8, and 25, would combining Cobbley and Narayanaswami to teach index information having an event indicator destroy the intended purpose of Narayanaswami?

4. Under § 103, has the Examiner erred by finding that Cobbley and Narayanaswami collectively would have taught or suggested:

(a) a method that includes searching the stored media file using the index information as recited in claim 4;

(b) the index information is transmitted from a media indexing beacon prior to being associated with a media file as recited in claim 5;

(c) a method that receives: (i) index information in response to an index information request in claim 6, or (ii) index information request generated by a media capture device as recited in claim 8; and

(d) index information comprises a time indicator or a global positioning system indicator in claim 7?

5. Under § 103, has the Examiner erred by finding that Cobbley and Narayanaswami collectively would have taught or suggested an index beacon as recited in claims 19 and 27?

6. Under § 103, has the Examiner properly formulated a case of obviousness for claim 21?

FINDINGS OF FACT

Appellant's Disclosure

1. Appellant defines “index information” as “information related directly to the subject of the media file” and, “[i]n the preferred embodiment, the indexing information is descriptive of the subject, i.e., is semantic content being captured in the media file.” Spec. ¶ 0009.

Cobbley

2. Cobbley discloses a broadcast source 105 that transmits broadcast information to a broadcast receiver 110. The broadcast information contains both the index information and video/audio information data. Alternatively, the index information is generated at the receiving end. Col. 3, ll. 37-51 and col. 4, ll. 45-50; Fig. 1.

3. Cobbley discloses that an index data capture device 112 obtains only the indexing information from the broadcast information, and capture device 115 obtains the rest of the broadcast information. The cache manager 125 then receives the index information from index data capture device 112 and the remainder of the broadcast information from the capture device 115. Col. 4, ll. 51-61 and col. 6, ll. 12-32; Fig. 1.

4. When Cobbley's indexing information and the broadcast information's remainder is sent to the cache manager 125 from index data capture device 112 and capture device 115, the indexing information is then correlated or associated with the indexing information with the video/audio data. Col. 4, ll. 2-12 and 59-61, col. 7, ll. 53-66, and col. 8, ll. 11-15; Fig. 1.

5. Cobbley discloses the cache manager 125 receives a request for a particular segment stored in cache 130 from an end user and retrieves the most recent version requested information for the user. Cache manager 125 also determines the most recent version of the requested information in cache 130 and returns the information to the user on a story segment basis. Col. 8, ll. 12-15 and col. 8, l. 45 – col. 9, l. 11; Fig. 1.

Narayanaswami

6. Narayanaswami teaches a capture device includes a global positioning system (GPS) receiver 114 for recording the geographic position (e.g., latitude, longitude, and altitude) of the capture device. The device also records a Universal Time Coordinated time and date and a local time and date when the image was taken. This recorded information can be used to determine if the image was taken indoors, under trees, or on a cloudy day. ¶ 0035; Fig. 1.

7. Narayanaswami teaches a watermark processor 134 for watermarking recorded parameters into the digital images to verify the images' authenticity and for indexing and searching photo albums. ¶ 0042; Fig. 1.

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073-74 (Fed. Cir. 1988).

“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

(1) *Claims 1-3*

ANALYSIS

Based on the record before us, we find no error in the Examiner’s obviousness rejection of representative independent claim 1 which calls for, in pertinent part, a media capture device to receive automatically index information separate from the media file from an external source. Appellant contends that Narayanaswami fails to disclose index information or receiving the index information separate from the media file. App. Br. 12-15. However, the Examiner has relied on Cobbley to teach the media capture device receives index information automatically and separately from the media file. Ans. 3-4. That is, Cobbley discloses an external source (e.g., broadcast source 105) that transmits broadcast information to a broadcast receiver 110. FF 2. This broadcast information contains both the index information and the media file (e.g., video/audio information data) or, alternatively, the index information is generated at the receiving end. *Id.* The latter alternative demonstrates an embodiment where the index information is received separate from the video/audio portion of the media file.

Moreover, Cobbley discloses the index data capture device 112 obtains only the indexing information from the broadcast information and device 115 obtains the rest of the broadcast information. *See* FF 3. Thus, when the media capture device (e.g., cache manager 125) receives the index

information from index data capture device 112 and the remainder of the broadcast information from the capture device 115 (*id.*), Cobbley's media capture device (e.g., cache manager 125) automatically receives index information separate from the media file from an external source (e.g., 105). Thus, contrary to Appellant's assertions (App. Br. 9-10; Reply Br. 2-3), we find that Cobbley discloses an embodiment where the index information is separate from the media file and separately received by the media capture device.

We therefore need not address Appellant's arguments regarding whether Narayanaswami teaches such a feature. App. Br. 12-15; Reply Br. 4. Furthermore, "[i]t is well settled that a prior art reference is relevant for all that it teaches to those of ordinary skill in the art." *In re Fritch*, 972 F.2d 1260, 1264 (Fed. Cir. 1992).

Additionally, Appellant argues that Narayanaswami fails to teach index information. We disagree. Narayanaswami discloses a capture device that measures various information, including geographic position, a time, and a date. FF 6. We find that this positional, temporal, and date information is "information related directly to the subject of the media file" or index information, as defined by Appellant. FF 1. That is, the location of the subject, the time filming the subject, and the date filming the subject is "index information" because each is information related directly to the subject of the media file. We also will not import the limitation that the information be "descriptive of the subject, i.e.,[] is the semantic content being captured in the media file" (*id.*) since this part of the disclosure describes a preferred embodiment. *See Superguide Corp. v. DirecTV Enter., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004).

Furthermore, Narayanaswami discloses the recorded geographic position, time, and date information (FF 6) can be watermarked and later used both for verifying authenticity and *indexing* the media content. FF 7. That is, Narayanaswami teaches the information is used both for watermarking *and* indexing. Thus, we not persuaded that Narayanaswami's "larger disclosure" would not be understood as indexing information. Reply Br. 4; *see also* App. Br. 12-14. Moreover, Narayanaswami's teachings clearly articulate and reasonably support the Examiner's position that such information is to be used for indexing and searching, contrary to Appellant's assertion that watermarking teaches away from such a combination. App. Br. 15-16. Additionally, we disagree that combining Cobbley with Narayanaswami renders Narayanaswami's watermarking feature unsatisfactory for its intended purpose of preventing data alteration. App. Br. 15-16. Rather, removing the indexing feature from Narayanaswami would destroy its intended purpose of using the recorded information to perform *both* watermarking and indexing (FF 7).

Finally, Appellant argues that Narayanaswami's index information does not contain an event indicator. App. Br. 14-15. Narayanaswami teaches that the recorded information can be used to determine if the image was taken indoors, under trees, or on a cloudy day (FF 6) – all specific events occurring while filming the subject based on the location and time. Thus, Narayanaswami teaches using location and time information to indicate "a specific event is occurring" as recited in claim 1.

For the foregoing reasons, Appellant has not shown error in the obviousness rejection of independent claim 1 based on Cobbley and Narayanaswami. We therefore sustain the rejection of claim 1, and claims 2 and 3 which fall with claim 1.

(2) Claim 4

We also find the Examiner has not erred in rejecting claim 4 based on Cobbley and Narayanaswami for the reasons previously discussed. Additionally, claim 4 recites the method further comprises *at least one* of: searching the stored media files using the index information *and* enabling a commercial system using the index information. Thus, given the alternative limitation format, Cobbley and Narayanaswami need only teach one of the recited steps. The Examiner finds, and we agree, that Cobbley teaches searching the stored media files. Ans. 5. Appellant has not disputed this finding. *See* App. Br. 16-17 (only discussing the “enabling a commercial system” limitation). Thus, the Examiner’s obviousness conclusion for claim 4 is therefore not persuasively rebutted.

(3) Claim 5

We further find the Examiner has not erred in rejecting claim 5 based on Cobbley and Narayanaswami for the reasons previously discussed. Appellant argues, without evidence, that Cobbley discloses no media indexing beacon. App. Br. 18. Mere lawyer’s arguments and conclusory statements that are unsupported by factual evidence are entitled to little

probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *see also In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984). Nonetheless, we find that Cobbley's broadcast source 105 reasonably corresponds to the recited media indexing beacon.

We also disagree that the claimed association that the index information must occur at the broadcast side (App. Br. 17-18) and, thus, the prior art fails to teach the index information is transmitted from the media indexing beacon prior to the index information being associated with the media file as recited in claim 5. First, as discussed above, Cobbley discloses one embodiment where the indexing information is generated on the receiving end. FF 2. Second, the indexing information is transmitted from the broadcast source 105 to the index data capture device 112 separately from the remainder of the broadcast information stored in the capture device 115. FF 3. Thus, when the indexing information is sent to the cache manager 125 along with the media file (e.g., the broadcast information's remainder) from capture device 115, the indexing information is then correlated or associated with the media file. FF 4. This transmission from the media index beacon (e.g., 105) is therefore prior to the association (e.g., at 125) as claimed.

For the foregoing reasons, Appellant has not shown error in the obviousness rejection of claim 5 based on the combination of Cobbley and Narayanaswami.

(4) Claim 6

Based on the record before us, we find no error in the Examiner's obviousness rejection of claim 6 which calls for receiving the index

information in response to an index information request. Appellant contends that Cobbley fails to disclose requesting indexing information from a media beacon. App. Br. 19. However, the scope of claim 6 requires receiving index information from an external source in response to an index information request and transmitting the index information from a media indexing beacon. As discussed above in connection with claim 5, we explained how Cobbley teaches transmitting index information from a media indexing beacon. The Examiner then discusses column eight of Cobbley to explain how the index information is received in response to an index information request (e.g., an end user's request). Ans. 6. Cobbley states that when the user makes a request for a particular segment (e.g., an index information request), cache manager 125 receives the index information request and retrieves the index information that has been transmitted by the media index beacon (e.g., 105). *See* FF 5.

For the foregoing reasons, Appellant has not shown error in the obviousness rejection of claim 6 based on the combination of Cobbley and Narayanaswami.

(5) Claim 7

We also find the Examiner has not erred in rejecting claim 7 based on Cobbley and Narayanaswami for the reasons previous discussed. Additionally, claim 7 recites the index information comprises *at least one* of the following: a time indicator, a landmark indicator, a global positioning system indicator, commercial information indicator, a universal resource locator, and a proximity locator. As explained above, given this alternative limitation format, Cobbley and Narayanaswami need only teach one of these

indicators or locators. The Examiner finds, and we agree, that Narayanaswami teaches a time and global positioning system indicator.

Ans. 8. Appellant has not disputed these findings, but rather focuses only on other alternative recitations (e.g., commercial information or universal resource locator). *See* App. Br. 19. Thus, the Examiner has presented an un rebutted conclusion of obviousness for claim 7.

(6) Claims 8 and 10-18

Regarding representative independent claim 8, Appellant cites to the previous discussion in connection with claim 1. App. Br. 19-20. Thus, the issues are the same as those in connection with claim 1, and we are unpersuaded by Appellant's arguments for the reasons indicated previously. Appellant also argues that neither reference teaches receiving an index information request that is generated by the media capture device. Cobbley, as discussed with regard to claim 6, discloses the cache manager or media capture device 125 receives a user request. FF 5. However, the media capture device also generates some type of indexing information request to retrieve the most recent version of the requested information and return the information to the user. *Id.* Moreover, Cobbley discloses the media capture device 125 constantly monitors the cache 130 for the most recent version of requested segment. *Id.* If a more recent version exists, the media capture device 125 requests a more current version of the segment (which includes index information) separate for the initial user's request. *Id.* We are therefore unpersuaded by Appellant's contention that neither reference teaches the limitation of "receiving an index information request that is generated by the media capture device" as recited in claim 8.

As for Cobbley failing to teach (1) an index information request (App. Br. 20), or (2) transmitting the index information relating to the subject separately to a media capture device (*id.*), we are unpersuaded by these arguments for the reasons indicated previously regarding claims 6 and 1 respectively.

For the foregoing reasons, Appellant has not shown error in the obviousness rejection of claim 8 based on the combination of Cobbley and Narayanaswami and claims 10-18, which fall with claim 8.

(7) Claims 19, 23, and 24

Based on the record before us, we find no error in the Examiner's obviousness rejection of representative independent claim 19 which calls for, in pertinent part, media indexing beacon that generates a beacon signal and a separate media capture device that captures the subject in a media file and separately receives the beacon signal. We are unpersuaded by Appellant's arguments (App. Br. 21) for the reasons indicated previously in connection with the media indexing beacon of claim 5 (e.g., broadcast source 105). Additionally, as we noted previously in connection with claim 1 regarding receiving index information, Cobbley's "media indexing beacon" (e.g., broadcast source 105) generates a "beacon signal" (e.g., indexing information within the broadcast information). *See* FF 2-3. Also, as discussed in connection with claim 1, Cobbley teaches a media capture device (e.g., cache manager 125) that captures the subject in a media file (e.g., from capture device 115) and separately receives the beacon signal (e.g., index information signal) from the media indexing beacon (e.g., 105) through index data capture device 112. *See* FF 3.

For the foregoing reasons, Appellant has not shown error in the obviousness rejection of claim 19 based on the combination of Cobbley and Narayanaswami and claims 20, 23, and 24, which fall with claim 19.

(8) Claims 25 and 29

As for representative claim 25, Appellant refers to the previous arguments of claims 1 and 8. App. Br. 21. We are therefore not persuaded by Appellant's contentions for the previous reasons set forth in connection with claims 1 and 8, and will sustain the rejection of claims 25 and 29.

(9) Claims 27 and 32

As for representative independent claim 27, Appellant contends claim 27 differs from claim 1, such as reciting a media indexing beacon, which is not taught by Cobbley. App. Br. 21-22. We disagree for the reasons discussed above in connection with claim 5.

(10) Claims 21 and 22

The Examiner presented a rejection of claims 21 and 22 based on Cobbley and Narayanaswami. See App. Br. 3, 11, and 12. In contrast, the Examiner has not stated anywhere in the Answer the rejection of claims 21 and 22 has been withdrawn. In addition, the Examiner agrees with Appellant that claims 21 and 22 are rejected under § 103 based on Cobbley, Narayanaswami, and Katseff. See App. Br. 1 and 7 (indicating claims 21 and 22 are rejected over Cobbley, Narayanaswami, and Katseff) and Ans. 2 (confirming the status of the claims and the grounds of rejection to be reviewed on appeal in the Appeal Brief are correct).

Moreover, the Examiner lists Katseff as evidence relied upon in the Answer. Ans. 2. While Katseff is noticeably absent from the discussion of claim 21 (Ans. 11-12), the Examiner's discussion regarding claim 22 does, however, mention Katseff (Ans. 12). Lastly, the Answer's Response to the Arguments section discussing claims 21 and 22 fails to clarify whether the Examiner relied on Katseff in formulating the rejection of claims 21 and 22. *See* Ans. 20 (only stating that "the rejection of claims 21 and 22 under 35 U.S.C. 103(a) is proper")

Based on the numerous inconsistencies in this record, we cannot determine whether Katseff has been relied upon to reject claims 21 and 22. Thus, the Examiner has not met the initial burden of presenting an adequate factual basis to support the legal conclusion of obviousness. *See Fine*, 837 F.2d at 1073-74; *Oetiker*, 977 F.2d at 1445.

For the foregoing reasons, Appellant has shown error in the obviousness rejection of claims 21 and 22.

CONCLUSIONS

Under § 103, the Examiner did not err in rejecting claims 1-8, 10-20, 23-25, 27, 29, and 32, but erred in rejecting claims 21 and 22.

ORDER

The Examiner's decision rejecting claims 1-8, 10-25, 27, 29, and 32 is affirmed-in-part.

Appeal 2009-004497
Application 10/064,477

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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